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PATENT

Attorney Docket No. CH920000077US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Stefan PLEISCH et al.

Serial No: 09/821,168

Filed: March 29, 2001

For: A FAULT-TOLERANT MOBILE
AGENT FOR A COMPUTER NETWORK

Examiner: Chad ZHONG

Art Unit: 2152

AMENDMENT AND RESPONSE TO OFFICE ACTION
CERTIFICATE OF SUBMISSION BY FACSIMILE

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Dear Sir:

I hereby certify that the following documents are being transmitted to the U.S. Patent and Trademark Office on the date shown below:

1. PETITION TO DIRECTOR UNDER 37 CFR §1.181 (3 pages); and
2. this CERTIFICATE OF SUBMISSION BY FACSIMILE (1 page).

If you did not receive all the pages, please telephone us at 718-544-1110, or fax us at 718-544-8588.

Respectfully submitted,

Dated: May 1, 2006



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PETITION TO DIRECTOR UNDER 37 CFR §1.181

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is made under 37 CFR §1.181 to review the finality of the Final Rejection mailed March 16, 2006 ("FOA") for the above-referenced patent application.

Statement of the Facts

A non-final Office Action was mailed on September 15, 2005, rejecting claim 10 under 35 U.S.C. §§ 112 and 102.

On December 15, 2005, the Applicants amended claim 10 as follows:

Claim 10. (currently amended) A computer program product comprising program code means for use for operating a mobile agent that travels through a network of a number of computers, wherein the mobile agent is executed in a sequence of stages and wherein each stage comprises a set of places, the computer program product comprising instructions for:

executing the mobile agent in at least one of the set of places of a respective one of the stages,
evaluating in which place of the respective stage the mobile agent has been executed successfully,
agreeing on a primary place among the set of places,
aborting and/or undoing any operation in connection with the mobile agent in any other place of the respective stage, ~~and~~
moving a modified mobile agent resulting from the successful execution to the next stage ~~from~~ to at least two forwarding places, and
generating a decision in each stage, the decision including the

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primary place that corresponds to the place in which the mobile agent has executed successfully, the set of places of the next stage to which the modified mobile agent is moved, and the resulting modified mobile agent.

Subsequently, a Final Office Action was mailed on March 13, 2006 rejecting claim 10 under 35 U.S.C. §101. FOA, pg. 2.

The Final Office Action states, "Claims 10, 14, 15, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 'a computer program product', 'program code means' are non-statutory subject matter, they are not operating within a tangible medium, appropriate correction is required." Id. The Office Action further states, "Applicant's remarks filed 12/15/2005 have been considered but are found not persuasive in view at [sic] the new grounds at [sic] rejection necessitated by Applicant's amendment." Id, pg. 6.

No information disclosure statements were submitted after the non-final Office Action mailed on September 15, 2005.

Argument

Under current practice, second or subsequent actions on the merits are final, "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" MPEP 706.07(a) (emphasis added). "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." MPEP 706.07.

In the present case, the rejection of claim 10 under 35 U.S.C. §101 in the Final Office Action was neither necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement. The amendment of claim 10 on December 15, 2005 had no connection to the rejection under 35 U.S.C. §101. Specifically, the amendment to claim 10 merely added a generating instruction to the computer product previously recited and corrected minor technical issues. The terms "a computer program product" and "program code means" objected to by the Examiner were not introduced to claim 10 by the Applicants' December 15, 2005 amendment.

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The rejection of claim 10 under 35 U.S.C. §101 could have been made in the non-final Office Action of September 15, 2005. More importantly, this rejection should have been made in the non-final Office Action in order to provide the Applicants an opportunity to fully respond to the 35 U.S.C. §101 issue.

For the reasons set forth above, the Applicants respectfully submit that the Final Rejection mailed March 16, 2006 is premature and the finality of this action should be withdrawn.

No fee is believed due with this Petition, however, should a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Respectfully submitted,



Dated: May 1, 2006

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